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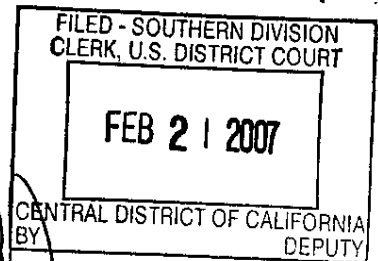
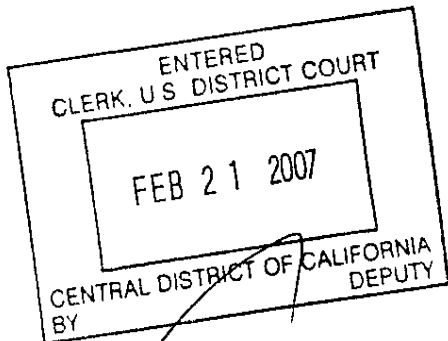
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**UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA**

FRANK ARMANNO,

Plaintiff(s),

v.

**PURICLE, INC. and WAL-MART
STORES, INC.,**

Defendant(s).

**CASE NO. SA CV 06-0626 DOC
(RNBx)**

**ORDER GRANTING
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT OF NON-
INFRINGEMENT**

**THIS CONSTITUTES NOTICE OF ENTRY
AS REQUIRED BY FRCP, RULE 77(d).**

Before Court is Defendants' Motion for Summary Judgment of Non-Infringement ("Motion"). After considering the moving, opposing and replying papers¹, and the oral arguments of the parties, the Court hereby GRANTS Defendants' Motion.

I. INTRODUCTION

This case involves devices that dispense cleaning and deodorizing agents into conventional flush toilet bowls when the toilet is flushed. Plaintiff Frank Armano filed this action on October

¹As a preliminary matter, the parties make a number of objections to evidence submitted. To the extent the Court relies on that evidence in this Order, these objections are OVERRULED.

U/S

21, 2005, in the District of Maryland, asserting that Defendants Puricle, Inc. ("Puricle") and Wal-Mart Stores, Inc. make and/or sell a product that infringes and contributes to or induces the infringement of Armanno's United States Patent Number 5,745,928 (the "'928 Patent"). On June 1, 2006, the Maryland District Court granted Puricle's Motion to Transfer Venue Pursuant to 28 U.S.C. § 1404(a), and transferred the case to the Central District of California.

The accused device, Puricle's "NeverScrub" toilet bowl cleaning system, is an apparatus installed in the tank of a conventional flush toilet between the toilet tank water inlet valve and the overflow tube. Armanno contends that Defendants' sales and offers for sale of the accused device infringe Claims 1 and 2 of the '928 Patent, in violation of 35 U.S.C. § 271. Defendants now move the Court for summary judgment of non-infringement.

II. CLAIM INTERPRETATION

Patent infringement analysis involves two steps: (1) an interpretation of the asserted claims, and (2) a comparison of the claims to the accused device. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384 (1996). Claim interpretation is a matter of law, *Markman*, 52 F.3d at 979, and is thus amenable to summary judgment, even though the analysis involves both issues of law and questions of fact. *Phonometrics Inc. v. N. Telecom Inc.*, 133 F.3d 1459, 1463-64 (Fed. Cir. 1998). Many courts, however, have chosen to hold a claim interpretation hearing, or *Markman* hearing, to facilitate the claim interpretation process. *See e.g., Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d 1572, 1577 (Fed. Cir. 1996).

Claim interpretation begins with the language of the claim. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed. Cir. 2002). Terms in the claim are generally given the ordinary and customary meaning they would have to a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). However, the terms must be read in the context of the entire patent. *Id.* at 1314. In interpreting the claims, the court focuses primarily on the intrinsic evidence of record, including the claims themselves, the specification, and if in evidence, the prosecution history. *Id.* at 1312-17.

1 Among the intrinsic evidence, the specification is always highly relevant to the claim
2 construction analysis – it is the single best guide to the meaning of a disputed term, and is usually
3 dispositive. *Id.* at 1315 (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.
4 Cir. 1996)). “The specification is, thus, the primary basis for construing the claims.” *Id.* (quoting
5 *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985)). In addition to the
6 specification, the court will also consider the prosecution history, which consists of “the
7 complete record” of the patent. *Id.* at 1317. However, because the prosecution history often
8 lacks the clarity of the specification, it is less useful for claim interpretation purposes. *Id.*

9 The ‘928 Patent contains three claims, the first two of which form the basis of Armanno’s
10 assertion of infringement. In relevant part, Claim 1 describes a cleaning agent dispenser, inserted
11 between a toilet’s water inlet pipe and its bowl refill tube, “consisting of”:

12 a cylindrical container having a closed bottom and an open top,
13 a removable cap for sealingly engaging the open top of said container,
14 said cap having an inlet port and an outlet port,
15 an inlet tube connected at one end to said secondary water outlet port,
16 another end of said inlet tube passing through the inlet port of said cap
17 and terminating proximate said closed bottom of said container,
18 an outlet tube communicating at one end with said bowl refill tube,
19 another end of said outlet tube passing through said outlet port and
20 terminating proximate said cap, and
21 a solid capsule of concentrated cleaning/deodorizing agent disposed at
22 the bottom of said container.

23 ‘928 Patent 6:20-36. Claim 2 depends on Claim 1, and adds “wherein said inlet tube and said
24 outlet tube are fabricated of a flexible material.” *Id.* at 6:37-39.

25 At issue here are the locations of the “inlet tube” and “outlet tube” with respect to the
26 patented device’s “cylindrical container.” Puricle submits that these claim limitations, and in fact
27 all of the claim limitations of Claims 1 and 2, should be construed according to the plain language
28

1 of the patent specification in their “ordinary sense as understood by those of skill in the toilet
 2 bowl cleaning art.”² Mot. 11:17-19. Armanno does not dispute this contention, and in fact offers
 3 no suggestion on the proper claim construction of the ‘928 Patent. Given no argument to the
 4 contrary, and seeing no reason to deviate from the specification’s ordinary language, the Court
 5 thus construes the ‘928 Patent so as to limit that the inlet and outlet tubes must pass through the
 6 agent dispenser cap.

7 **III. SUMMARY JUDGMENT STANDARD**

8 Summary judgment is proper if “the pleadings, depositions, answers to interrogatories, and
 9 admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any
 10 material fact and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P.
 11 56(c).

12 The Court must view the facts and draw inferences in the manner most favorable to the non-
 13 moving party. *United States v. Diebold, Inc.*, 369 U.S. 654, 655, 82 S. Ct. 993, 994 (1962);
 14 *Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1161 (9th Cir. 1992). The moving party bears the
 15 initial burden of demonstrating the absence of a genuine issue of material fact for trial, but it need
 16 not disprove the other party’s case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256, 106 S.
 17 Ct. 2505, 2514 (1986); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-25, 106 S. Ct. 2548, 2553-
 18 54 (1986). When the non-moving party bears the burden of proving the claim or defense, the
 19 moving party can meet its burden by pointing out the absence of evidence of a genuine issue of
 20 material fact from the non-moving party. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d
 21 795, 806-07 (Fed. Cir. 1999).

22 Once the moving party meets its burden, the “adverse party may not rest upon the mere
 23 allegations or denials of the adverse party’s pleading, but the adverse party’s response, by affidavits
 24 or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine
 25

26 ²Neither party presents extensive testimony interpreting these limitations from one
 27 who proffers to be “of skill in the toilet bowl cleaning art.” The Court is confident,
 28 however, that it is capable based on its own experiences of discerning how such a person
 would understand the claims.

1 issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be
2 entered against the adverse party.” Fed. R. Civ. P. 56(e); *see also Anderson*, 477 U.S. at 248-49,
3 106 S. Ct. at 2510. Furthermore, a party cannot create a genuine issue of material fact simply by
4 making assertions in its legal papers. There must be specific, admissible evidence identifying the
5 basis for the dispute. *S.A. Empresa de Viacao Aerea Rio Grandense v. Walter Kidde & Co., Inc.*,
6 690 F.2d 1235, 1238 (9th Cir. 1980). “The mere existence of a scintilla of evidence . . . will be
7 insufficient; there must be evidence on which the jury could reasonably find for [the opposing
8 party].” *Anderson*, 477 U.S. at 252, 106 S. Ct. at 2512.

9 IV. INFRINGEMENT

10 After interpreting the asserted claims to determine their meaning and scope, a court
11 performing a literal infringement analysis must determine whether those claims read on the
12 accused product. *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed. Cir. 1995).
13 “To establish literal infringement, every limitation set forth in a claim must be found in an accused
14 product, exactly.” *Id.* Here, Armano concedes that the NeverScrub device does not literally
15 infringe on the ‘928 Patent, as its inlet and outlet tubes do not pass through the agent dispenser
16 cap. He nonetheless maintains that the accused device infringes under the doctrine of equivalents.

17 Under the doctrine of equivalents, a patent holder is able to claim “those insubstantial
18 alterations that were not captured in drafting the original patent claim but which could be created
19 through trivial changes.” *Festo v. Shoketsu Kinzoku Kogyo Kabushiki*, 535 U.S. 722, 730, 122
20 S. Ct. 1831 (2002). “Infringement under the doctrine of equivalents requires that the accused
21 product contain each limitation of the claim or its equivalent.” *AquaTex Indus. v. Techniche*
22 *Solutions*, 419 F.3d 1374, 1382 (Fed. Cir. 2005) (citing *Warner-Jenkinson Co. v. Hilton Davis*
23 *Chem. Co.*, 520 U.S. 17, 40, 117 S. Ct. 1040 (1997)). A particular element in the accused product
24 is equivalent to a limitation in the claim if the differences between them are insubstantial. *Id.* The
25 court’s analysis focuses on whether the element in the accused product “performs substantially the
26 same function in substantially the same way to obtain the same result as the claim limitation.” *Id.*
27 (quoting *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608, 70 S. Ct. 854
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1 (1950) (internal quotation omitted).

2 Defendants do not argue that the accused device's inlet and outlet tubes are not equivalent
3 to those described in the '928 Patent, but instead argue that Armanno is not entitled to assert
4 equivalence. This argument is rooted in the doctrine of prosecution history estoppel (formerly
5 known as file wrapper estoppel).

6 **A. The Doctrine of Prosecution History Estoppel**

7 Prosecution history estoppel precludes a patentee from benefitting from the doctrine of
8 equivalents over subject matter that the patent holder relinquished during prosecution in order to
9 obtain allowance of the claim. *Mark I Marketing Corp. v. R.R. Donnelley & Sons Co.*, 66 F.3d
10 285, 291 (Fed. Cir. 1995) (citing *Zenith Lab, Inc. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424
11 (Fed. Cir. 1994)). Once estoppel applies, there is no range of equivalents available to the patentee
12 for the amended claim element. *Festo Corp.*, 535 U.S. at 740-41. It is important to note that not
13 all amendments give rise to prosecution history estoppel. See *Andrew Corp. v. Gabriel Elec. Inc.*,
14 847 F.2d 819, 825 (Fed. Cir. 1988). But estoppel does apply to an amended claim element where
15 the patentee, for any reason related to the requirements for patentability, enacted a narrowing
16 amendment. *Festo Corp.*, 535 U.S. at 736. In such instances, prosecution history estoppel
17 requires that claims be interpreted by reference to those "that have been cancelled or rejected."
18 *Id.* at 734 (quoting *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220, 61 S. Ct.
19 235 (1940)).

20 In other words, "[w]hen the patentee has chosen to narrow a claim, courts may presume the
21 amended text was composed with awareness of [prosecution history estoppel] and that the territory
22 surrendered is not an equivalent of the territory claimed." *Festo Corp.*, 535 U.S. at 741. Where
23 the prosecution history is silent as to the motivation behind a narrowing amendment, a patentee
24 seeking to obtain the benefit of equivalence therefore bears the burden of establishing a reason
25 other than patentability for the amendment. See *Warner-Jenkinson*, 520 U.S. at 33. The patentee
26 must be given the opportunity to rebut this presumption, but the patentee's argument must be based
27 solely upon the public record. *Sextant Avionique, S.A. v. Analog Devices, Inc.* 172 F.3d 817, 828
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(Fed. Cir. 1999); *Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352, 1356 (Fed. Cir. 2003) (“Only the public record of the patent prosecution, the prosecution history, can be a basis for [a plaintiff’s motivation to amend].”). The Court then decides, as a matter of law, whether the proffered reason is sufficient to overcome prosecution history estoppel. *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1368-69 (Fed. Cir. 1999); *Warner-Jenkinson*, 520 U.S. at 33.

B. Prosecution History of the ‘928 Patent

The ‘928 Patent issued on May 5, 1998 and contains three claims, two of which depend on the patent’s sole independent claim. Armanno originally filed for this patent on January 11, 1996, when the United States Patent and Trademark Office (“USPTO”) assigned it Serial Number 08/548,239 (the “‘239 Application”). The ‘239 Application contained five claims, one of which was independent and recited a conventional flush toilet including a “sealed agent chamber” with a removable cap and a “cap inlet line” and a “cap outlet line” that were “placed through the cap and sealed to the cap about its outside periphery.” Decl. of Clark S. Stone Ex. B at 15-16. Armanno filed a Preliminary Amendment to the ‘239 Application, which added Claims 6 through 8. *Id.* at 21-23. Claim 6 was an independent claim, which consisted of a conventional flush toilet including a “sealed agent chamber” with an “inlet line” and an “outlet line” that were placed as follows:

(b) An *inlet line placed through a wall* of said agent chamber and sealed to said agent chamber about the outside periphery of said inlet line in contact with said agent chamber,

(c) An *outlet line placed through a wall* of said agent chamber and sealed to said agent chamber about the outside periphery of said outlet line in contact with said agent chamber

Id. (emphasis added).

The USPTO rejected all eight claims of the ‘239 Application on June 9, 1996. *Id.* at 24-31. Among other findings, the USPTO explained that all eight claims were indefinite and that “Claims 1-3 and 6-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by [U.S. Patent No. 5,042,095 (“Schoepe”).” *Id.* at 26, 28. On September 11, 1996, Armanno responded to this

1 rejection with an amended application wherein he added Claims 9-14, amended Claim 6, and
2 argued that Schoepe did not anticipate the '239 Application because "the storage chamber [of
3 Schoepe] is not directly connected in series with the refill line, as is done in the present
4 invention." *Id.* at 41-43, 45.

5 The USPTO was again unconvinced, and on October 31, 1996 it rejected all of the claims
6 still pending in the '239 Application in a Final Office Action. *Id.* at 51-56. In particular, the
7 USPTO again rejected Claim 6 as anticipated by Schoepe. *Id.* at 53. Following this rejection,
8 Armano abandoned the '239 Application, which the USPTO noted in mailing a Notice of
9 Abandonment on May 27, 1997. *Id.* at 60.

10 Just prior to the abandonment of the '239 Application, on April 30, 1997, Armano filed a
11 File Wrapper Continuation Application, which the USPTO assigned Serial Number 08/841,590
12 (the "'590 Application"). *Id.* at 62-64. An amendment to the '590 Application cancelled all of
13 Claims 1, 4-6, and 9-14 of the '239 Application, and added new claims numbered 15-17. *Id.* at 65-
14 69. These new claims ultimately issued as Claims 1-3 of the '928 Patent.

15 **C. Armano is Estopped from Asserting Equivalence**

16 In light of this prosecution history, Armano is estopped from now asserting that the
17 accused device's side wall inlet and outlet tubes are equivalent to those described in the '928
18 Patent, which must pass through the agent dispenser cap. Because the Court examines a patent's
19 prosecution history as a whole in determining whether estoppel applies, the '928 Patent's relevant
20 history includes not only the '590 Application, but also the parent '239 Application history. *See*
21 *Jonsson v. Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990) (prosecution history of parent
22 application is relevant to understanding scope of claims issuing in a continuation-in-part
23 application). Specifically, Armano's abandonment of the elements claimed in Claim 6 of the
24 '239 Application now trigger estoppel.

25 In adding Claim 6 to the '239 Application by the Preliminary Agreement, Armano
26 expressly stated:

27 The purpose of the addition of claims 6, 7, and 8 is to claim the
28

1 invention in broader terms. There is no need to restrict the inlet and
2 outlet lines in their connection with the chamber to the chamber cap.

3 These connections can be made directly to the chamber just as well.

4 Stone Decl. Ex. B at 23. The USPTO rejected this claim, at least in part because it was anticipated
5 by Schoepe, which also discloses inlet and outlet lines made directly to any of the walls of the
6 agent delivery chamber. Schoepe Patent 6:18-19, 6:42-44 (disclosing "walls forming a transfer
7 chamber lying adjacent to said storage chamber, said transfer chamber having an inlet coupled to
8 said refill water outlet and having an outlet coupled to said standpipe"). Armanno then proceeded
9 to narrow the patent application so as to cancel Claim 6 and to distinguish it from Schoepe, which
10 did not disclose a removable top cap, by adding a new claim explaining that the inlet and outlet
11 tubes must pass through the agent's removable dispenser cap. This "narrowing amendment for a
12 reason related to patentability raises a presumption of prosecution history estoppel that may be
13 rebutted by the patentee on stated grounds." *Sulzer Textile A.G. v. Picanol N.V.*, 358 F.3d 1356,
14 1368 (Fed. Cir. 2004).

15 The Supreme Court has outlined three instances in which "the patentee can overcome the
16 presumption that prosecution history estoppel bars a finding of equivalence":

17 The equivalent may have been unforeseeable at the time of the
18 application; the rationale underlying the amendment may bear no more
19 than a tangential relation to the equivalent in question; or there may be
20 some other reason suggesting that the patentee could not reasonably
21 be expected to have described the insubstantial substitute in question.

22 *Festo Corp.*, 535 U.S. at 740-41. Armanno does not attempt to argue, let alone identify
23 supporting evidence in the public record, that any of these three exceptional qualities here applies.
24 Moreover, the first and third exceptions are plainly inapplicable, as Armanno did foresee and in
25 fact did describe the disputed equivalent in Claim 6 of the '239 Application.

26 Instead, Armanno misconstrues the law in arguing that he is only estopped from reclaiming
27 those equivalents he specifically surrendered, and that Defendants bear the burden of
28

1 demonstrating that this clear and deliberate surrender. To this effect, he relies on two cases. The
2 first of these cases, *Pordy v. Land O' Lakes, Inc.*, 97 F. App'x 921 (Fed. Cir. 2004), is an
3 unpublished case, prefaced with a notice that it "was issued as unpublished or nonprecedential and
4 may not be cited as precedent." The second of these cases, *Hughes Aircraft Co. v. United States*,
5 717 F.2d 1351 (Fed. Cir. 1983), has been reversed in relevant part and is no longer legal
6 precedent. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 574 (Fed. Cir.
7 2000) ("Today, we revisit the question we first addressed in *Hughes* [] and come to a different
8 conclusion as to the proper scope of equivalents that is available when prosecution history
9 estoppel applies than we did in that case. We hold that prosecution history estoppel acts as a
10 complete bar to the application of the doctrine of equivalents when an amendment has narrowed
11 the scope of a claim for a reason related to patentability.").


12 Aside from the fact that these authorities upon which Armanno relies are not valid
13 precedent, his legal argument is simply wrong. As the Court has already explained, a patentee
14 seeking to obtain the benefit of equivalence bears the burden of establishing a reason other than
15 patentability for a narrowing amendment. See *Warner-Jenkinson*, 520 U.S. at 33. Armanno
16 cannot lift that burden, and accordingly, Defendants are entitled to summary judgment of non-
17 infringement.

18 **V. DISPOSITION**

19 For the reasons set forth above, Defendants' Motion is GRANTED.

20
21 IT IS SO ORDERED.

22 DATED: February 21, 2007

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25

DAVID O. CARTER
26 United States District Judge
27
28